

REMARKS

A. Background

Claims 32-33 and 35-50 were pending in the application at the time of the Office Action. The Office Action objected to claims 32-33, 35-36, 44-46 and 49 based on informalities. Claims 32-33, 35-36 and 44-46 were objected to as containing new matter. Claims 32-33, 35-36, 44-46 and 49 were rejected as being indefinite. Claims 32-33 and 35-49 were rejected as being anticipated by cited art. By this response applicant has amended claims 32, 37, 38, 42, 47 and 48 and cancelled claims 39 and 40. As such, claims 32-33, 35-38, and 41-50 are presented for the Examiner's consideration in light of the following remarks.

B. Proposed Amendments

Applicant has herein amended the specification to correct various typographical and grammatical errors. Applicant has amended claims 32, 37, 38, 42, 47 and 48 to further clarify, more clearly define, and/or broaden the claimed inventions to expedite receiving a notice of allowance. The amendments to the claims are supported in the application at least by Figures 5-7, 9, and 11 and the corresponding discussion in the specification. In view of the foregoing, Applicant submits that the amendments to the claims do not introduce new matter and entry thereof is respectfully requested.

C. Rejection on the Merits

1. Written Description Rejection

Page 2 of the Office Action rejects claims 32-33, 35-36, 44-46 and 49 under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. In particular

the Office Action objects to the element of claim 32 which recites “so that the rasp body can reciprocate relative to the rasp guide.” Specifically, the Office Action asserts that the limitation is new matter because “since the rasp guide is received within an opening of the rasp body, the rasp guide is stationary with respect to the rasp body.” Applicant disagrees.

As depicted in Figure 6 and discussed at Paragraph [0063] of the specification as originally filed, the specification teaches that rasp guide 106 is smaller than guide slot 122 of rasp body 104. As a result, rasp guide 106 can reciprocate or move within guide slot 102 so that rasp guide 106 can move relative to rasp body 104 when received within guide slot 102. During use, as discussed at Paragraphs [0070]-[0071] of the specification as originally filed, retention rod 102 is secured to rasp guide 106 so as to hold rasp guide 106 substantially stationary. In turn, a reciprocal driver is secured to rasp body 104 so as to reciprocate rasp body 104 relative to the substantially stationary rasp guide 106.

In view of the foregoing and the referenced support in the specification, applicant submits that the claim language, “so that the rasp body can reciprocate relative to the rasp guide,” as recited in claim 32, is supported by the specification as originally filed and thus withdrawal of the rejection is respectfully requested. Claims 33, 35-36 and 44-46 were rejected for depending from claim 32. Applicant therefore submits that the rejection of these claims should also be withdrawn for at least the same reasons as provided above in connection with claim 32.

The Office Action also objects to the language in claim 49 which recites “wherein a portion of the rasp guide projects from the opening and past the bottom surface of the rasp body.” Applicant notes that support for this claim element can be found at least in Figures 9A and 9B and in claim 35 as originally presented. Specifically, as depicted in Figures 9A and 9B and discussed at Paragraph [0063], forks 132A and B, which form a portion of rasp guide 106,

project through opening 128 and thus extend past the bottom surface of rasp body 104. In view of this support, Applicant submits that the rejection of claim 49 has been overcome and should be withdrawn.

2. Indefiniteness Rejection

Page 2 of the Office Action rejects claims 32-33, 35-36 and 44-46 under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office Action asserts that the recitation “so that the rasp body can reciprocate relative to the rasp guide” is vague and indefinite since the functional recitation is not supported by recitation of adequate structure in the claim. The Office Action asserts that the “rasp guide is received within a slot of the rasp body so it is unclear how the rasp body can reciprocate relative to the rasp guide, since the rasp body and rasp guide would move together.” Office Action, page 2 and 3.

As discussed above in detail in the rejection of claim 32 under 35 USC § 112, first paragraph, the specification teaches one embodiment of the claimed invention where the rasp guide is smaller than the slot in which it is received. As such, the rasp guide can reciprocate within the slot and thus can reciprocate relative to the rasp body. Applicant submits that the language “so that the rasp body can reciprocate relative to the rasp guide,” as recited in claim 32, is clear and definite in that the scope of the limitation is clearly understood. That is, one skilled in the art knows what it means to say that one structure can reciprocate relative to another, especially in light of the teachings in the present specification. As such, withdrawal of the rejection is respectfully requested.

Claims 33, 35-36 and 44-46 were rejected for depending on claim 32. Applicant therefore submits that the rejections of these claims also be withdrawn for at least the same reasons as provided above in connection with claim 32.

3. Anticipation Rejections

i. Rejection based on Michelson

Page 3 of the Office Action rejects claims 32 and 46 under 35 USC § 102(b) as being anticipated by U.S. Patent No. 6,159,214 to Michelson (“*Michelson*”). Applicant respectfully traverses this rejection. Of the rejected claims, claim 32 is the sole independent claim. Applicant submits that *Michelson* does not anticipate claims 32 and 46 because *Michelson* does not include each and every claim limitation recited in the rejected claims.

With reference to Figures 59-61, *Michelson* discloses a milling block 801 which the Office Action equates to the claimed “rasp guide.” Milling block 81 has a narrow track 807 which receives an oscillating blade 809. The Office Action equates the blade 809 to the claimed “rasp body.” With reference to Figure 14, *Michelson* also discloses a handle 140 that can attach to milling block 801 and which the Office Action equates to the claimed “retention rod.” Assuming the foregoing interpretation as set forth in the Office Action, applicant asserts that *Michelson* does not disclose or suggest the invention as recited in claim 32.

Specifically, because blade 809 does not have an opening that extends from a bottom side on which the cutting edges are formed to an opposing top side, *Michelson* does not disclose or suggest “a rasp body having a bottom surface with a plurality of cutting edges and an opposing top surface with an opening extending from the bottom surface to the top surface.” as recited in claim 32. Likewise, because blade 809 of *Michelson* does not have the above discussed

“opening” extending therethrough, *Michelson* also does not disclose or suggest “the rasp guide being mounted on the rasp body in alignment with the opening on the rasp body so that at least a portion of the rasp guide is accessible at or through the bottom surface of the rasp body” or “the rasp guide, the retention rod, or the combination thereof projecting entirely through the opening on the rasp body.” as also recited in claim 32.

In view of the foregoing, Applicant respectfully requests that the 102(b) rejection of claim 32 in view of *Michelson* be withdrawn. Claims 46 depends from claim 32 and thus incorporates the limitations thereof. As such, Applicant submits that claim 46 is distinguished over *Michelson* for at least the same reasons as discussed above with regard to claim 32. Accordingly, Applicant respectfully requests that the 102(b) rejection of claim 46 also be withdrawn.

ii. Rejection based on Hamada

Pages 3-4 of the Office Action reject claims 32-33, 35, 46 and 47 under 35 USC § 102(b) as being anticipated by U.S. Patent No. 6,436,101 to Hamada (“*Hamada*”). Applicant respectfully traverses the rejection. Of the rejected claims, claims 32 and 47 are independent claims. Applicant submits that *Hamada* does not anticipate claims 32-33, 35, 46 and 47 because *Hamada* does not include each and every claim limitation recited in the rejected claims.

Hamada discloses the use of an impactor for inserting intervertebral implants. Abstract. More specifically, with reference to Figure 33, *Hamada* discloses an impactor 401 having a tubular, outer sleeve 403. A pair of compressible jaws 405 and 407 are coupled with outer sleeve 403 by a draw bolt 427 so that as the draw bolt 427 is tightened, jaws 405 and 407 are compressed together. Jaws 405 and 407 are used to hold and insert an implant 210 that is

designed for positioning between adjacent vertebra of a spine. Implant 210 has a plurality of line slots 207 (Figure 32) to “provide more surface area to promote bone growth and a stronger fusion with the adjacent vertebra.” Col. 16, line 66-Col. 17 line 1.

The Office Action equates implant 210 with the claimed “rasp body;” jaw 407 with the claimed “rasp guide” and outer sleeve 403 with draw bolt 427 as the claimed “retention rod.” Applicant asserts that even under that above interpretation, *Hamada* does not disclose or suggest all of the limitations of claim 32.

Initially, line slots 207 of implant 210 merely provide more surface area on the implant to promote bone growth. Line slots 207 are not configured as and do not form “cutting edges.” Furthermore, other than line slots 207, there are no openings formed on implant 210. Likewise, there are no openings that extend all the way through implant 210. As such *Hamada* does not disclose or suggest “a rasp body having a bottom surface with a plurality of cutting edges and an opposing top surface with an opening extending from the bottom surface to the top surface,” as recited in claim 32. Likewise, because implant 210 of *Hamada* does not have the above discussed “opening” extending therethrough, *Hamada* also does not disclose or suggest “the rasp guide being mounted on the rasp body in alignment with the opening on the rasp body so that at least a portion of the rasp guide is accessible at or through the bottom surface of the rasp body” or “the rasp guide, the retention rod, or the combination thereof projecting entirely through the opening on the rasp body.” as also recited in claim 32.

With regard to Claim 47, for substantially the same reasons as discussed above with regard to claim 32, applicant asserts that *Hamada* does not disclose or suggest “a rasp body having an arched bottom surface with an opening and a plurality of cutting edges formed thereon” or “wherein the retention rod or the means for removably engaging extends

through the opening on the rasp body.” as recited in claim 47. Furthermore, claim 47 has a means plus function clause which recites “means for removably engaging the retention rod with the rasp body such that the rasp body can be selectively reciprocated without movement of the retention rod.” *Hamada* discloses jaws 405 and 407 which are designed to rigidly secure implant 210 to outer sleeve 403 with draw bolt 427. As such, *Hamada* does not disclose or suggest “means for removably engaging the retention rod with the rasp body such that the rasp body can be selectively reciprocated without movement of the retention rod.” as recited in claim 47.

In view of the foregoing, Applicant respectfully requests that the 102(b) rejection of claims 32 and 47 be withdrawn. Claims 33, 35 and 46 depend from claim 32 and thus incorporate the limitations thereof. As such, applicant submits that claims 33, 35 and 46 are distinguished over *Hamada* for at least the same reasons as discussed above with regard to claim 32. Accordingly, Applicant respectfully requests that the 102(b) rejection of claims 33, 35 and 46 be withdrawn.

iii. Rejection based on Cohen

Page 4 of the Office Action rejects claims 37-43 and 48 under 35 USC § 102(b) as being anticipated by U.S. Patent No. 5,356,414 to Cohen et al. (“*Cohen*”). Applicant respectfully traverses this rejection. Of the rejected claims, claims 37 and 48 are independent claims. Applicant submits that *Cohen* does not anticipate claims 37-43 and 48 because *Cohen* does not include each and every claim limitation recited in the rejected claims.

With reference to Figure 6, *Cohen* discloses a base plate 96 which the Office Action equates with the claimed “first resecting template” and a tibial punch 130 which the Office

Action equates with the claimed “retention rod.” Even assuming arguendo that base plate 96 corresponds to the claimed “first resecting template,” tibial punch 130 engages with base plate 96 from the top surface thereof and there is no structure in *Cohen* that engages with the bottom surface of base plate 96. As such, *Cohen* does not disclose or suggest both “**a retention rod having a first end removably connected to the resecting template from the bottom surface of the first resecting template, the retention rod projecting away from the bottom surface at an orientation away from the top surface**” and “**a rasp having a first end slidably positioned within one of the plurality of elongated open channels from the top surface of the first resecting template, the rasp projecting away from the top surface at an orientation away from the bottom surface,**” as recited in claim 37.

In view of the foregoing, Applicant respectfully requests that the 102(b) rejection of claims 37 be withdrawn. Claims 38-43 depend from claim 37 and thus incorporate the limitations thereof. As such, applicant submits that claims 38-43 are distinguished over *Cohen* for at least the same reasons as discussed above with regard to claim 37. Accordingly, Applicant respectfully requests that the 102(b) rejection of claims 38-43 be withdrawn.

With respect to claim 48, the Office Action asserts that cutting head 138, as depicted in Figure 8 of *Cohen*, corresponds to the claimed “rasp body,” the tower 110 corresponds to the claimed “rasp guide,” and the shaft of tibial punch 130 corresponds to the claimed “retention rods.” Even assuming this interpretation, *Cohen* does not disclose or suggest all of the claim elements. For example, cutting head 138 does not have an opening formed on the bottom surface thereof and a portion of tower 110 is not secured within an opening formed on the bottom surface of cutting head 138. As such, *Cohen* does not disclose or suggest “**a rasp body having a bottom surface with a plurality of cutting edges formed thereon and an opening being**

formed on the bottom surface” or “a rasp guide having at least a portion thereof secured within the opening formed on the bottom surface of the rasp body,” or the rasp guide, the retention rod, or the combination thereof projecting entirely through the opening on the rasp body.” as recited in claim 48. In view of the foregoing, Applicant respectfully requests that the 102(b) rejection of claim 48 be withdrawn.

iv. Rejection based on Masse

Page 5 of the Office Action rejects claims 32-33 and 46-49 under 35 USC § 102(b) as being anticipated by U.S. Patent No. 4,739,750 to Masse et al. (“*Masse*”). Applicant respectfully traverses the rejection. Of the rejected claims, claims 32, 47 and 48 are independent claims. Applicant submits that *Masse* does not anticipate claims 32-33 and 46-49 because *Masse* does not include each and every claim limitation recited in the rejected claims.

With reference to Figure 1, *Masse* discloses a rasp having a handle 1 mounted on a toothed blade 2. The blade 2 includes “a fixed portion 3 fixed to the handle 1, and a moving portion 4.” Col. 2, lines 36 and 37. Portions 3 and 4 are secured together by a screw 5. Screw 5 is “fixed in translation” on moving portion 4 by a “shoulder 52 and a spring clip 6 received in the base of the fixed blade portion 3.” Col. 2, lines 53-55. In turn, the threaded shank 50 of screw is threaded into a tapped hole 42 on moving portion 4 so that rotation of screw 5 facilitates controlled separation between portions 3 and 4.

The Office Action asserts that moving portion 4 corresponds to the claimed “rasp body,” that fixed portion 3 and screw 5 in combination correspond to the claimed “rasp guide,” and that handle 1 corresponds to the claimed “retention rod.” Specifically, the Office Action states that “peg 50 projects through an opening in the rasp body such that it projects beyond the bottom

surface of the rasp body, the peg being slidably or capable of being slid relative to the rasp guide.” Applicant disagrees.

As discussed above, *Masse* teaches that threaded shaft 50 of screw 5 is threaded into moving portion 4. This threaded engagement precludes screw 5 from freely reciprocating relative to moving portion 4. Furthermore, as discussed above fixed portion 3 is fixed to screw 5 by shoulder 52 and a spring clip 6. Accordingly, when screw 5 is threaded through moving portion 4, *Masse* does not disclose or suggest the combination of “the rasp guide, the retention rod, or the combination thereof projecting entirely through the opening on the rasp body,” and the “rasp guide mounted on the rasp body so that the rasp body can freely reciprocate relative to the rasp guide,” as recited in claim 32. Likewise *Masse* does not disclose or suggest the combination of “the rasp guide, the retention rod, or the combination thereof projecting entirely through the opening on the rasp body,” and “the rasp guide being freely slidable relative to the rasp body,” as recited in claim 48.

Similarly, for substantially the same reasons as discussed above with regard to claims 32 and 48, applicant submits that *Masse* does not disclose or suggest “means for removably engaging the retention rod with the rasp body such that the rasp body can be selectively reciprocated without movement of the retention rod, wherein the retention rod or the means for removably engaging extends through the opening on the rasp body,” as recited in claim 47.

In view of the foregoing, Applicant respectfully requests that the 102(b) rejections of claims 32, 47, and 48 be withdrawn.

Claims 33 and 46 depend from claim 32 and claim 49 depends from claim 48 and thus incorporate the limitations thereof. As such, applicant submits that claims 33, 46 and 49 are

distinguished over *Masse* for at least the same reasons as discussed above with regard to claims 32 and 48. Accordingly, Applicant respectfully requests that the 102(b) rejection of claims 33, 46 and 49 be withdrawn.

4. Allowable Subject Matter

Applicant thanks the Examiner for the careful review of claim 50 and the allowance thereof.

No other objections or rejections are set forth in the Office Action.

D. Conclusion

Applicant notes that this response does not discuss every reason why the claims of the present application are distinguished over the cited prior art. Most notably, applicant submits that many if not all of the dependent claims are independently distinguishable over the cited prior art. Applicant has merely submitted those arguments which it considers sufficient to clearly distinguish the claims over the cited prior art.

In view of the foregoing, applicant respectfully requests the Examiner's reconsideration and allowance of claims 32-33, 35-38, and 41-50 as amended and presented herein.

In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Dated this 5th day of May 2009.

Respectfully submitted,

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